

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed July 11, 2005. Claims 1-20 are pending in this application. Claims 1, 2, 6-8, 12-14, and 18-20 are rejected in the Office Action. Claims 3-5, 9-11, and 15-17 are objected to. For at least the reasons discussed below, Applicants respectfully request reconsideration and favorable action in this case.

Allowable Subject Matter

Applicants note with appreciation the Examiner's indication that Claims 3-5, 9-11, and 15-17 would be allowable if rewritten in independent form. However, because Applicants believe that independent claims 1, 7, 13 and 19-20 are allowable (as discussed below), these dependent claims have not been amended.

Section 102 Rejections

The Examiner rejects Claims 1, 7, 13, and 19-20 under U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,847,702 issued to Czerwie et al. ("Czerwie").

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987); M.P.E.P. § 2131. In addition, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claims" and "[t]he elements must be arranged as required by the claim." *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); M.P.E.P. § 2131 (*emphasis added*).

Claim 1 of the present application recites the following limitations:

A method for test head testing of a connection in a synchronous optical network (SONET) element, comprising:
dedicating an otherwise assignable output port of a SONET network element as a test access port;
receiving a request to connect a connection switched by a switch fabric of the SONET network element to the test access port;
determining whether the request is associated with a test head; and

if the request is associated with the test head, provisioning the switch fabric to connect the connection to the test access port.

Independent Claims 7, 13, and 19-20 recite similar, although not identical, limitations.

Applicants respectfully submit that Claim 1 (as well as Claims 7, 13, and 19-20) is allowable because *Czerwie* does not disclose each and every one of these limitations. For example, *Czerwie* does not disclose dedicating an otherwise assignable output port of a SONET network element as a test access port. The Examiner argues that this limitation is taught in Figures 8 and 9 of *Czerwie*. However, these figures, along with the rest of *Czerwie*, discloses testing of a DSL system and connection – not a SONET connection as required by the claims. Therefore, *Czerwie* does not teach dedicating an output port of a SONET network as a test access port. Although Figure 2 of *Czerwie* discloses a network termination card (37) having a SONET port (21), this SONET port is not related to the testing function of *Czerwie*. The testing is performed using the test head and the test access card. In any case, the SONET port of the network termination card is certainly not dedicated as a test access port.

In addition, Applicants respectfully submit that there is no disclosure in *Czerwie* of determining whether a request to connect a connection to the test access port is associated with a test head and deciding whether to provision a switch fabric based on the determination. For a teaching of these limitations, the Examiner refers to Col. 9 lines 10-17 (the Examiner cites to Col. 9 for a teaching of the last limitation of Claim 1, but does not include line numbers). Applicant can find no part of Column 9 or any other portion of *Czerwie* that discloses any sort of determination of whether to make a connection to a test access port based on the element with which the request is associated.

For at least these reasons, Applicants respectfully request reconsideration and allowance of Claims 1, 7, 13, and 19-20, as well as the claims that depend from these independent claims.

Section 103 Rejections

The Examiner rejects Claims 2, 8, and 14 under U.S.C. § 103(a) as being unpatentable *Czerwie* in view of U.S. Publication No. 2002/0120853 issued to Tyree (“*Tyree*”). The Examiner also rejects Claims 6, 12, and 18 under U.S.C. § 103(a) as being unpatentable *Czerwie* in view of U.S. Patent No. 6,370,154 issued to Wickham (“*Wickham*”).

Claims 2, 6, 8, 12, 14 and 18 each depend from one of independent Claims 1, 7 or 13, which have been shown above to be in condition for allowance. Although these claims include additional limitations that Applicants believe are not disclosed in the cited references, Applicants submit that these claims are at least allowable given their dependence on Claims 1, 7 or 13. Therefore, Applicants respectfully request reconsideration and allowance of Claims 2, 6, 8, 12, 14 and 18.

CONCLUSION

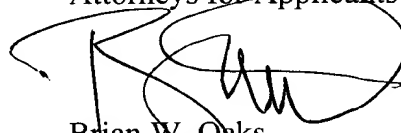
Applicants have made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicants respectfully request full allowance of all the pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Brian W. Oaks, Attorney for Applicants, at the Examiner's convenience at (214) 953-6986.

Although Applicants believe no fees are due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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